

temperature or CV properties. However, the rejection states that “it is reasonable to presume” that the properties are inherent to the knitted or woven fabric taught by Chen in view of Aranishi. The Applicants disagree.

The Applicants first note that it is completely improper to rely on inherency in combining references under 35 USC §103. While it may be permitted to rely on inherency in the context of §102 and possibly under §103 when that section is applied over a single reference, it is not proper to rely on inherency based on a combination. As noted above, this rejection is based on the combination of Aranishi with Chen under §103. Thus, the Applicants respectfully submit that the alleged inherency argument is improper in this instance and cannot be relied upon to reject the solicited claims. Hence, the combination must fail on that basis alone.

Nonetheless, the Applicants will provide comments which disprove any notion of inherency of various of the Applicants’ claimed aspects.

First, the Applicants note that the method of producing cellulose acetate fibers as disclosed by Chen is a dry-spinning method or a wet-spinning method. This is specifically and clearly set forth in col. 3 of Chen beginning at line 4:

The spinning process used to produce a cellulose acetate dressing can be either dry spinning or wet spinning as those terms are understood by one skilled in the art.

Those skilled in the art understand dry spinning and wet spinning to be different from melt spinning. Why is this important? This is important because the Applicants melt spin their fibers. The result of that different method brings about different fibers having different physical characteristics.

In particular, fibers made of either a dry-spinning method or a wet-spinning method have deformations in the cross section. Such deformations result from evaporation of the solvent

during spinning. On the other hand, the Applicants' melt-spinning methodology results in substantial uniformity of the cross section of the fibers so that the coefficient of variation (CV) in single yarn fineness is 10% or less. In other words, the Applicants' fibers are substantially uniform, while the fibers of Chen are poor in uniformity in the cross section of the fibers. This means that the physical characteristics of the Chen fibers (setting aside the teachings of Aranishi for the moment) would inherently be different from the physical characteristic of the Applicants' claimed fibers.

Importing the cellulose acetate propionate from Aranishi into the Chen methodology does not change the result. In other words, Chen would still use the dry-spinning method or the wet-spinning method which is different from the Applicants' melt-spinning method. Thus, one skilled in the art would have a reasonable expectation that the fibers resulting from the combination of Aranishi with Chen would be different from those of the Applicants because they still rely on the dry-spinning method or the wet-spinning method which causes problems with respect to uniformity in the cross section of the fibers which impacts the coefficient of variation in single yarn fineness.

Therefore, even if it was proper to rely on inherency when combining references under §103, the reliance on inherency would still be misplaced because those skilled in the art would have a reasonable expectation that there would be differences between the Applicants' claimed fibers and those resulting from a Chen/Aranishi method. This is particularly devastating since the requirements for inherency are quite high. Inherency must be established to a degree that the claimed characteristic is "necessarily" present. The Applicants respectfully submit that this rejection does not rise even close to that high hurdle. It is not enough that a physical characteristic might be present or could be present. It must necessarily be present. The

Applicants have established that the use of different methodologies between Chen and the Applicants would cause one skilled in the art to have a reasonable expectation that the physical characteristics such as the CV value would likely be quite different indeed. Withdrawal of the rejection is accordingly respectfully requested.

In light of the foregoing, the Applicants respectfully submit that the entire application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,



T. Daniel Christenbury
Reg. No. 31,750
Attorney for Applicants

TDC/vp
(215) 656-3381